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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,921	09/22/2003	Ioana M. Rizoiti	BI9100CIPCON	9901
33197 7590 04/01/2008 STOUT, UXA, BUYAN & MULLINS LLP 4 VENTURE, SUITE 300 IRVINE, CA 92618				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3735				
MAIL DATE		DELIVERY MODE		
04/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/667,921

Applicant(s)

RIZOIU ET AL.

Examiner

david shay

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 9, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-48, 52-59 and 65-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-48, 52-59 and 65-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The amendment filed July 20, 2006 and August 8, 2007 are objected to under 35 U.S.C. 132(a) because they introduce new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the presumption and assertion that the priority of 60/064,465 is inherent despite its deletion from the continuing data.

With regard to the request for interview, the examiner notes that Mr. Mullins contacted the examiner by telephone on February 10, 2008 regarding the finality of the office action mailed July 13, 2007, at which point the examiner reminded applicant that this subject had already been discussed and that the examiner had already agreed that the office action of July 13, 2007 had been erroneously been made final. The examiner also pointed out that the office action of July 13, 2007 had already been made logged as non-final, as evidenced by the fact that the amendment filed January 9, 2008 had been entered as an amendment after non-final rejection. No other aspect of the final rejection or the amendments filed subsequent the office action of July 13, 2007 were discussed at either interview.

The examiner apologizes for the inadvertent omission of the claims 54, 65, and 66, and applicant's subsequent assumption of the allowability of these claims predicated on this omission. However, as a general rule, it should be noted that the rejection of claims dependant on a given claim (e.g. rejection of claim 55, dependant on claim 54, as in the instant case), should be construed as an indication that the independent claim, too, is rejected. Similarly, the additional limitations of claims 65 and 66, the use of a fluid comprising water and comprising anesthetic, respectively are contained in the base reference, Rizoïu et al (WO '928), e.g. at the

sentence bridging pages 48 and 49, and the sentence bridging pages 52 and 53, respectively.

Thus clearly these limitations cannot be the basis of the patentability of the claims.

The examiner has taken official notice that of the obviousness of configuring devices for and using devices for the removal of fat in joints or the abdomen since these are known sites of fat tissue; to employ sterile fluids, since this prevents infection when operating on internal tissue; to construct the device from medical grade plastics, since this is a notorious material for medical devices; and to construct the device of stainless steel, since this is a notorious material for medical devices and is inert. Applicant has not challenged these determinations and they are now considered admitted prior art.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 39-46, 48, 52, 53, and 65-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizoiu et al (WO '928) in combination with Paolini et al, Messangill, and the admitted prior art of configuring devices for and using devices for the removal of fat in joints or the abdomen since these are known sites of fat tissue; to employ sterile fluids, since this prevents infection when operating on internal tissue; to construct the device from medical grade plastics, since this is a notorious material for medical devices; and to construct the device of stainless steel, since this is a notorious material for medical devices and is inert. Rizoiu et al (WO '928) teach a tissue removal device and method with hydrokinetic energy generated by the claimed lasers and using water, epinephrine and/or anesthetic as the fluid. Paolini et al teach having the zone wherein ablative energy used to act upon the tissue to be removed interacts therewith beyond the distal end of the cannula. Messangill teaches the removal of fat tissue using a

cannula which delivers hydrokinetic energy to the tissue to be removed. It would have been obvious to the artisan or ordinary skill to employ the hydrokinetic energy generators and steps and fluids of Rizoïu et al (WO '928) in the method and device of Massengill, since Massengill teaches no particular laser and since the claimed fluids are equivalent and or compatible with water when generating the hydrokinetic energy, as taught by Rizoïu et al (WO '928); or to employ the cannula delivery system and steps of Massengill in the device and method of Rizoïu et al (WO '928) , since Rizoïu et al (WO '928) teaches that the device and method can be used on many kinds of tissue and can include many different types of instruments; and in either case, to configure the device such that the interaction zone is beyond the end of the cannula as taught by Paolini et al, since this is not critical; is well within the skill of one having ordinary skill in the art; and provides no unexpected result; to employ the method on and configure the device for removal of fat tissue in joints or the abdomen since these are known sites of fat tissue, official notice of which has already been taken; to employ sterile fluids, since this prevents infection when operating on internal tissue, official notice of which has already been taken; to construct the device from medical grade plastics, since this is a notorious material for medical devices, official notice of which has already been taken; and to construct the device of stainless steel, since this is a notorious material for medical devices and is inert, official notice of which has already been taken any disruptive forces will propagate in all directions and act on any tissue which is in the cannula, thus producing a device and method such as claimed.

Claims 47, 54-59, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizoïu et al (WO '928) in combination with Paolini et al, Massengill, and the admitted prior art of configuring devices for and using devices for the removal of fat in joints or the abdomen since

these are known sites of fat tissue; to employ sterile fluids, since this prevents infection when operating on internal tissue; to construct the device from medical grade plastics, since this is a notorious material for medical devices; and to construct the device of stainless steel, since this is a notorious material for medical devices and is inert as applied to claims 39-46, 48, 52, 53, and 65-68 above, and further in combination with Kittrell et al. Kittrell et al teach a tissue removal device with imaging capabilities. It would have been obvious to the artisan of ordinary skill to provide the infrared imaging device of Kittrell et al. in the device of Rizoïu et al (WO '928) in combination with Paolini et al, Massengill since this would enable the surgeon to assure that the tissue is kept at a safe temperature, since this will minimize the damage to nerves and blood vessels, thus producing a device such as claimed.

Applicant's arguments filed August 28, 2007 and January 9, 2008 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3735